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Mailed: November 10, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re State Street Palazzio Trattoria Italiana, Inc.

Serial No. 76490830

Richard T. Lyon of Lyon & Harr for State Street Palazzio
Trattoria Italiana, Inc.

Edward Nelson, Trademark Examining Attorney, Law Office
106.

Before Hanak, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

State Street Palazzio Trattoria Italiana, Inc.
(applicant) seeks to register in typed drawing form GO FISH
AND CHIPS for "restaurant services." The application was
filed on February 23, 2003 with a claimed first use date of
October 2002. At the request of the Examining Attorney,
applicant disclaimed the exclusive right to use FISH AND
CHIPS apart from the mark in its entirety.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to restaurant services, is likely to cause confusion with the mark GO FISH, previously registered in typed drawing form for "restaurant services." Registration No. 1,683,385, issued April 14, 1992, Section 8 affidavit accepted, renewed.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the services, they are legally identical. Both are described as simply "restaurant services."

Turning to a consideration of the marks, we note at the outset that when the goods or services of the parties

are legally identical as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In addition, we note that applicant seeks to register its mark GO FISH AND CHIPS in typed drawing form. Of course, the cited mark GO FISH is registered in typed drawing form. This means that applicant's mark is not limited to being "depicted in any special form," and hence we are mandated to "visualize what other forms the mark might appear in." Phillips Petroleum Co. v. C.J. Webb Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992).

If applicant were to obtain a typed drawing registration of its mark GO FISH AND CHIPS, then applicant would be free to depict the GO FISH portion of its mark in large lettering on one line, and to depict the AND CHIPS portion of its mark in far smaller lettering on a second line. When so depicted, the overall commercial impression of applicant's mark would be extremely similar to the registered mark GO FISH. If applicant's mark were so depicted, consumers could well overlook the AND CHIPS portion of applicant's mark, or if they even noticed that

portion, they could simply assume that registrant had now added these subordinate words (AND CHIPS) to its mark GO FISH to make it clear that registrant offered fried potatoes.

In arguing that there is no likelihood of confusion, applicant notes at page 3 of its brief that the registered mark GO FISH brings to mind the sport of fishing, or perhaps a children's card game. Continuing at pages 3 and 4 of its brief, applicant states that the term "fish and chips" is a unitary expression that merits its own listing in some dictionaries, citing The American Heritage Dictionary. It is defined as a food combination consisting of fried fish and fried potatoes. Merriam Webster Dictionary (Online November 2004). Thus, according to applicant, the two marks have distinctly different meanings. Registrant's mark brings to mind the sport of fishing, or perhaps a children's card game. On the other hand, applicant's mark brings to mind a particular food combination, namely, fish and chips.

We agree with applicant that the meanings of the phrases "go fish" and "go fish and chips" are different. However, this Board is mandated to follow the teachings of Phillips Petroleum. If we consider, as we must, applicant's mark being depicted with the GO FISH portion in

a very prominent fashion and the AND CHIPS portion in a decidedly subordinate fashion, then many consumers may not even notice the AND CHIPS portion of applicant's mark and thus would not be able to differentiate the two marks in terms of meaning or connotation.

Of course, it need hardly be said that to the extent that there are doubts on the issue of likelihood of confusion, we are obligated to resolve such doubts in favor of the registrant. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993).

Decision: The refusal to register is affirmed.